

REMARKS

Applicant has carefully reviewed the Office Action mailed November 3, 2006 and offers the following remarks to accompany the above amendments.

Applicant has amended claim 1 by adding "in the mobile terminal and" to the first limitation and "in the mobile terminal and" to the second limitation, and "associated with a first indicia" to the third limitation. Applicant has amended claim 19 by adding "in a mobile terminal" to the first limitation and "in the mobile terminal" to the second limitation, as well as "associated with a first indicia" to the third limitation. Claims 12 and 30 have been amended to reflect appropriate antecedent basis in view of the other amendments. Support for these amendments can be found throughout the Specification, generally, and particularly in Figure 2 and in paragraphs [0004], [0020], [0022], [0023], [0025], [0026], and [0033]. Claim 35 has been amended to correct a typographical error.

Before addressing the rejections, Applicant provides a brief summary of the present invention so that the remarks relating to the rejections are considered in the proper context. The present invention is directed to a mobile terminal having a first interface to establish communication sessions over a first communication network by a wired connection, and a second interface to establish communication sessions over a second communication network by a local wireless or cellular connection. A control system establishes the communication sessions associated with a first indicia over the first and second communication networks via the first and second interfaces. If a wired connection is available, the control system establishes a communication session via the first interface. If the communication session established via the wired interface becomes no longer possible, a new communication session may be established via the local wireless interface. In addition, separate addresses may be associated with the mobile terminal when using the wired and local wireless interfaces.

Claims 1-17 and 19-35 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0038400 A1 to Fukushima (hereinafter "Fukushima"). Applicant respectfully traverses. For the Patent Office to prove anticipation, each and every element of the claims must be present in the reference. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

Claim 1, as amended, recites "a first interface in the mobile terminal and adapted to facilitate communications via a wired connection to a first communication network." Fukushima

is directed to a personal computer that has a communication interface to establish wireless communication with an external device, but does not have a communication interface to establish wired communication with an external device. In Fukushima, the personal computer must be docked in a docking station to establish wired communication with an external device. Therefore, in Fukushima, the docking station, not the personal computer, has the communication interface for wired communication. (Fukushima, paragraph [0090]). In other words, the personal computer in Fukushima cannot establish wired communication without the docking station. As such, Fukushima does not disclose "a first interface in the mobile terminal and adapted to facilitate communications via a wired connection to a first communication network."

Also, claim 1, as amended, recites a control system adapted to "establish communication sessions associated with a first indicia over the first and second communication networks via the first and second interfaces." Fukushima does not disclose a first indicia and, therefore, does not disclose establishing communication sessions associated with a first indicia.

Since Fukushima does not disclose "a first interface in the mobile terminal and adapted to facilitate communications via a wired connection to a first communication network," or a control system adapted to "establish communication sessions associated with a first indicia over the first and second communication networks via the first and second interfaces," Fukushima does not disclose each and every element of claim 1. Accordingly, Fukushima does not and cannot anticipate claim 1 and, therefore, claim 1 is allowable. Withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b) is respectfully requested.

Claim 19, as amended, is a method claim and recites the same elements as claim 1, except in method format. Therefore, claim 19 is similarly not anticipated by Fukushima and is allowable for at least the same reasons as claim 1. Withdrawal of the rejection of claim 19 under 35 U.S.C. § 102(b) is respectfully requested.

Further, claims 2-17 depend from claim 1 and claims 20-35 depend from claim 19. Since dependent claims contain all of the limitations of the claims from which they depend, claims 2-17 and 20-35 are not anticipated by Fukushima for at least the same reasons as claims 1 and 19. Accordingly, claims 2-17 and 20-35 are similarly allowable and withdrawal of the rejection of claims 2-17 and 20-35 under 35 U.S.C. § 102(b) is respectfully requested. Notwithstanding this, certain dependent claims require special mention.

Claims 3 and 21 each recite "wherein communications via the first interface are associated with a first address and communications via the second interface are associated with a second address." The Patent Office cites to Figures 5 and 6 and Paragraph [0090] to support the rejection of claims 3 and 21 and argues that "inherent in paragraph 0090, wireless router in Figs. 5-6 would assign an IP address to both wireless and wired individually." (Office Action mailed November 3, 2006, page 3, second paragraph). Figures 5 and 6 in Fukushima, though, do not show a router. Figures 5 and 6 show an access point station 65, but that is not a router. Also, and as confirmation of this point, Fukushima does not mention a router in paragraph 0090, or any place else. Therefore, not only does Fukushima not disclose assigning IP addresses, Fukushima does not disclose a router on which the Patent Office bases its inherency argument.

Since the Patent Office believes that assigning an IP address to both wireless and wired connections is inherent within Fukushima, the Patent Office is obligated to provide evidence to prove such inherency. Since the portions of Fukushima cited by the Patent Office do not disclose a router or assigning an IP address, the Patent Office has not cited to any portion of Fukushima that supports or provides evidence of the inherency. All that remains then is the Patent Office's statement. The Patent Office's statement, without more, is not sufficient. *Com'l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). Accordingly, claims 3 and 21 are not anticipated by Fukushima and are allowable for this additional reason. Withdrawal of the rejection of claims 3 and 21 under 35 U.S.C. § 102(b) is again respectfully requested.

Claim 8 depends from claim 3 and claim 26 depends from claim 21. Since dependent claims contain all of the limitations of the claims from which they depend, claims 8 and 26 are not anticipated by Fukushima and are allowable for at least the additional reason applied to claims 3 and 21. Withdrawal of the rejection of claims 8 and 26 under 35 U.S.C. § 102(b) is again respectfully requested.

Claims 4-7 recite "wherein the control system is further adapted to register with a service node." Similarly, claims 22-25 recite "registering with a service node." The Patent Office cites to paragraph 0090 of Fukushima to support the rejection of claims 4-7 and 22-25. (Office Action mailed November 3, 2006, pages 3-4). Fukushima, though, does not mention a service node in paragraph 0090, or any place else. Therefore, Fukushima cannot and does not disclose "registering with a service node." Accordingly, Fukushima does not disclose each and every limitation of claims 4-7 and 22-25. Since Fukushima does not disclose each and every limitation

of claims 4-7 and 22-25, claims 4-7 and 22-25 are not anticipated by Fukushima and are allowable for this additional reason. Withdrawal of the rejection of claims 4-7 and 22-25 under 35 U.S.C. § 102(b) is again respectfully requested.

Claims 18 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukushima in view of U.S. Patent No. 6,475,146 B1 to Frelburger et al. (hereinafter "Frelburger"). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

Claim 18 depends from claim 1 and claim 36 depends from claim 19. Since dependent claims contain all of the limitations of the claims from which they depend, claims 18 and 36 include the limitation of a control system adapted to "establish communication sessions associated with a first indicia over the first and second communication networks via the first and second interfaces." As discussed above, Fukushima does not disclose this limitation. Combining Fukushima with Frelburger does not make up for this deficiency. Accordingly, the combination of Fukushima with Frelburger does not teach or suggest each and every element of claims 18 and 36. Therefore, the Patent Office has failed to establish a *prima facie* case of obviousness and, as such, claims 18 and 36 are allowable. Withdrawal of the rejection of claims 18 and 36 under 35 U.S.C. § 103(a) is respectfully requested.

Moreover, there must be some teaching or suggestion in Fukushima and Frelburger to provide the motivation to combine them. Additionally, the Patent Office not only must articulate a motivation for such combination to show obviousness, but also must support such articulated motivation with actual evidence found in Fukushima and Frelburger. The Patent Office has not supported its articulated motivations with any evidence found in Fukushima and Frelburger. The Patent Office states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate cellular interface taught by Frelburger et al. into the

mobile terminal and method of Fukushima, in order to facilitate telephony service.” (Office Action mailed November 3, 2006, page 7). The Patent Office does not cite to any portion of Fukushima or Frelburger to support such statement. Frelburger is directed to a personal digital assistant (PDA) used to control diagnostic medical ultrasound systems. (Frelburger, Abstract). Fukushima is directed to personal computers connected to an expansion device, such as a docking station. (Fukushima, Abstract). Therefore, it would be unreasonable for one of ordinary skill in the art to consider Frelburger as a candidate for combination with Fukushima in order to teach or suggest some aspect of personal computers and docking stations not taught or suggested by Fukushima. Accordingly, since Fukushima and Frelburger are directed to such disparate environments, there can be no motivation in either Fukushima or Frelburger to evidence such combination.

Since the Patent Office has not supported its articulated motivation for combining Fukushima with Frelburger with actual evidence found in Fukushima and Frelburger, the Patent Office has failed to establish *prima facie* obviousness of claims 18 and 36 based on such combination. For this additional reason, claims 18 and 36 are allowable. Withdrawal of the rejection of claims 18 and 36 under 35 U.S.C. § 103(a) is again respectfully requested.

Further, Applicant submits that Frelburger is non-analogous art, and, as non-analogous art, Frelburger is not a proper reference and is not properly combinable with Fukushima. MPEP § 2141.01(a). To be a proper reference, the reference must either be in the field of endeavor of the Applicant’s invention, or the reference must have “logically commended itself to an inventor’s attention in considering his problem.” *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). As discussed above, Frelburger is directed to a personal digital assistant (PDA) used to control diagnostic medical ultrasound systems, while Fukushima is directed to personal computers connected to an expansion device, such as a docking station. As such, Frelburger is clearly not in the field of endeavor of Fukushima. Also, Frelburger would not have logically commended itself to the attention of the inventor of the present invention for any purpose.

Accordingly, since Frelburger is neither in the field of endeavor of the present invention, nor would it have logically commended itself to the inventors of the present invention, Frelburger is not a proper reference and the Patent Office’s use of Frelburger to support a rejection under 35 U.S.C. § 103(a) is improper, by itself or in combination with Fukushima. For

this additional reason, the Patent Office has failed to establish *prima facie* obviousness of claims 18 and 36 based on the combination of Fukushima with Frelburger. Accordingly, claims 18 and 36 are allowable. Withdrawal of the rejection of claims 18 and 36 under 35 U.S.C. § 103(a) is again respectfully requested.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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